



ATTORNEY DOCKET NO. 25006.0001U5
SERIAL NO. 10/038,718
Page 1 of 1

Form PTO-1449
U.S. DEPARTMENT OF COMMERCE (Rev. 7-80)
PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NO.: 25006.0001U5

SERIAL NO. 10/038,718
CONFIRMATION NO. 4062

APPLICANT: Lizardi

LIST OF PRIOR ART CITED BY APPLICANT
(Use several sheets if necessary)

FILING DATE: January 2, 2002

GROUP: 1655

EXAMINER INITIALS		DOCUMENT NO.	DATE	NAME	CLAS S	SUBCLASS	FILING DATE IF APPROPRIATE
	B1	6,124,120	Sep. 26, 2000	Lizardi			
	B2	6,143,495	Nov. 7, 2000	Lizardi et al.			
	B3	6,280,949	Aug. 28, 2001	Lizardi			
	B4	6,287,824	Sep. 11, 2001	Lizardi			
	B5	6,316,229	Nov. 13, 2001	Lizardi et al.			
	B6	6,329,150	Dec. 11, 2001	Lizardi et al.			

EXAMINER:

DATE CONSIDERED:

10/6/02

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Form PTO-1449				Complete if Known				
U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE				Application Number	10/038,718			
LIST OF INFORMATION CITED BY APPLICANT (Use as many sheets as necessary)				Filing Date	January 2, 2002			
				First Named Inventor	Paul M. Lizardi			
				Group Art Unit	1634			
				Examiner Name	Ethan C Whisenant			
U.S. PATENT DOCUMENTS								
Examiner's Initials	Cite No.	Document No.	Date	Name	Class	Subclass	Filing Date (if appropriate)	
[Signature]	C1	5,866,336	02/02/99	Nazarenko et al.	[Signature]	[Signature]	[Signature]	
	C2	5,876,924	03/02/99	Zhang et al.				
	C3	5,942,391	08/24/99	Zhang et al.				
	C4	6,033,881	03/07/00	Himmler et al.				
	C5	6,096,880	08/01/00	Kool et al.				
	C6	6,117,635	09/12/00	Nazarenko et al.				
	C7	6,221,603 B1	04/24/01	Mahtani et al.				
	C8	6,255,082 B1	07/03/01	Lizardi et al.				
	C9	6,291,187 B1	09/18/01	Kingsmore et al.				
	C10	6,323,009 B1	11/27/01	Lasken et al.				
FOREIGN PATENT DOCUMENTS								
Examiner's Initials	Cite No.	Foreign Patent Document Country Code-Number-Kind Code	Date	Name	Translation Yes/No			
[Signature]	C11	EP 0 745 690 A2	12/04/96	The Public Health Research Institute of the City of New York, Inc.				
	C12	WO 00/71562 A1	11/30/00	The Public Health Research Institute of the City of New York, Inc.				
	C13	WO 97/19193	05/29/97	Yale University				
	C14	WO 99/31276	06/24/99	Nexstar Pharmaceuticals, Inc.				
NON-PATENT DOCUMENTS								
Examiner's Initials	Cite No.	Non-Patent Citations (include Author, Title, Publisher, Relevant Pages, Date and Place of Publication)						
[Signature]	C15	Baner et al. Signal Amplification of Padlock Probes by Rolling Circle Replication, <i>Nucleic Acids Research</i> , Oxford University Press, Surrey, 26(22):5073-5078 (1998), XP002112357						
	C16	Gusev et al. Rolling Circle Amplification: A New Approach to Increase Sensitivity for Immunohistochemistry and Flow Cytometry, <i>American Journal of Pathology</i> , 159(1): 63-69 (July 2001)						
	C17	Lizardi et al. Mutation Detection and Single-Molecule Counting Using Isothermal Rolling-Circle Amplification, <i>Nature Genetics</i> , 19:225-232 (1998)						
	C18	Mullenix et al. Allergen-specific IgE Detection on Microarrays Using Rolling Circle Amplification: Correlation with in Vitro Assays for Serum IgE, <i>Clinical Chemistry</i> , 47(10):1926-1929 (2001)						
	C19	Nuovo, et al. In Situ Amplification Using Universal Energy Transfer-labeled Primers, <i>The Journal of Histochemistry & Cytochemistry</i> , The Histochemical Society, Inc., New York, New York 43(3):273-279 (1999), XP008002684						
	C20	Schweitzer et al. Immunoassays with Rolling Circle DNA Amplification: A Versatile Platform for Ultrasensitive Antigen Detection, <i>PNAS</i> , 97(18):10113-10119 (August 29, 2000)						
	C21	Schweitzer et al. Multiplexed Protein Profiling on Microarrays by Rolling-Circle Amplification, <i>Nature Biotechnology</i> , 20:359-365 (April 2002)						
	C22	Tyagi et al. Molecular Beacons: Probes that Fluoresce upon Hybridization, <i>Nature Biotechnology</i> , 14:303-308 (March 1996), XP000196024						
	Examiner Signature: [Signature]				Date Considered: 10/6/02			
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Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	09/044,723 <i>Unassigned</i>
		Filing Date	August 29, 2000 <i>Hercwith</i>
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
		Examiner Name	
Sheet 1 of 12	Attorney Docket Number	YU 115 CON 127 25006.0001US	

U.S. PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	US Patent Document		Name of Patentee or Applicant of Cited Document	Date of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
		4,883,750		Whiteley, et al.	11-28-1989	
		4,965,188		Mullis et al.	10-23-1990	
		4,994,373		Stavrianopoulos, et al	02-19-1991	
		5,001,050		Blanco et al.	03-19-1991	
		5,198,543		Blanco et al.	03-30-1993	
		5,242,794		Norman, et al.	09-07-1993	
		5,328,824		Ward, et al.	07-12-1994	
		5,354,668		Jeffrey I. Auerbach	10-11-1994	
		5,409,818		Davey et al.	04-25-1995	
		5,455,166		Walker	10-03-1995	
		5,521,065		Whiteley, et al.	05-28-1996	
		5,591,609		Jeffrey I. Auerbach	01-07-1997	
		5,614,389		Jeffrey I. Auerbach	03-25-1997	
		5,714,320		Eric T. Kool	02-03-1998	
		5,733,733		Jeffrey I. Auerbach	03-31-1998	
		5,854,033		Lizardi	12-29-1998	

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Examiner Initials ¹	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ²
		Office. ³	Number ⁴	Kind Code ⁵ (if known)				
		WO	92/01813		Syngene, Inc.	02-16-1992		
		WO	94/24312		Beckman Instruments, Inc.	10-27-1994		
		WO	95/03432		Bio-Rad Laboratories, Inc.	02-02-1995		
		WO	95/22623		Landegren, Ulf	12-24-1995		

Examine Signature	<i>[Signature]</i>	Date Considered	10/6/02
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




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Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	09/644,723 Unassigned
		Filing Date	August 23, 2000 Hereafter
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
		Examiner Name	
Sheet 2 of 12	Attorney Docket Number	YU 115 CON (2) 25006.0001US	

U.S. PATENT DOCUMENTS						
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FOREIGN PATENT DOCUMENTS								
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		Office. ²	Number ⁴	Kind Code ⁵ (if known)				
  		WO	95/35390		Mount Sinai School of Medicine of the City University of New York	12-28-1995		
		WO	97/20948		Hofman-Bang & Boutard, Lehmann & Ree	06-12-1997		
		WO	97/42346		Tepnel Medical Limited	11-13-1997		
		EP	0 128 332	A2	Enzo Biochem, Inc.	12-19-1984		
		EP	0 356 021	A2	Imperial Chemical Industries PLC	02-28-1990		
		EP	0 439 182	B1	Abbott Laboratories	07-31-1991		
		EP	0 505 012	A2	F. Hoffmann-La Roche, AG	09-23-1992		
		EP	0 667 393	A2	Enzo Diagnostics, Inc.	08-16-1995		
		JP	4262799		Toyobo Co. LTD.	09-18-1992		
		JP	4304900		Toyobo Co. LTD.	10-28-1992		
	AU	649066		Syngene, Inc.	05-12-1994			

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Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Complete if Known			
		Application Number	09/044,729 Unassigned		
		Filing Date	August 22, 2000 Herein		
		First Named Inventor	Paul M. Lizardi		
		Group Art Unit			
		Examiner Name			
Sheet	3	of	12	Attorney Docket Number	YU 115 CON (2) 2500.0001 US

OTHER ART -- NON PATENT LITERATURE DOCUMENTS			
Examiner's Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
		ABRAVAYA, et al., "Detection of point mutations with a modified ligase chain reaction (Gap-LCR)", <i>Nucleic Acids Res.</i> 23(4): 675-682 (1995).	
		ALIOTTA, et al., "Thermostable Bst DNA polymerase lacks a 3'-5' proofreading exonuclease activity," <i>Genet. Anal.</i> 12:185-195 (1996).	
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		ARNOLD, et al., "Assay Formats Involving Acridinium-Ester-Labeled DNA Probes", <i>Clin. Chem.</i> 35(8): 1588-1594 (1989).	
		BARANY, "Genetic disease detection and DNA amplification using cloned thermostable ligase", <i>Proc. Natl. Acad. Sci. USA</i> 88: 189-193 (1991).	
		BERTINA, et al., "Mutation in blood coagulation factor V associated with resistance to activated protein C", <i>Nature</i> 369: 64-67 (1994).	
		BIRKENMEYER & MUSHAHWAR, "DNA probe amplification methods", <i>Journal of Virological Methods</i> 35: 117-126 (1991).	
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		BLANCO, et al., "Terminal protein-primed DNA amplification", <i>Proc. Natl. Acad. Sci. USA</i> 91: 12198-12202 (1994).	

Examiner's Signature		Date Considered	10/6/03
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		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
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		Attorney Docket Number	YU 115 CON (2) 2000.0001 US
Sheet	4	of	12

OTHER ART -- NON PATENT LITERATURE DOCUMENTS			
Examiner's Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
		BOEHMER & LEHMAN, "Herpes Simplex Virus Type 1 ICP8: Helix-Destabilizing Properties", <i>Journal of Virology</i> 67(2): 711-715 (1993).	
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		DAUBENDIEK, et al., "Generation of catalytic RNAs by rolling transcription of synthetic DNA nanocircles," <i>Nature Biotechnology</i> 15:273-277 (1997).	
		DAUBENDIEK, et al., "Rolling-Circle RNA Synthesis: Circular Oligonucleotides as Efficient Substrates for T7 RNA Polymerase," <i>J. Am. Chem. Soc.</i> 117:7818-7819 (1995).	
		DAVANLOO, et al., "Cloning and expression of the gene for bacteriophage T7 RNA polymerase", <i>Proc. Natl. Acad. Sci. USA</i> 81: 2035-2039 (1984).	
		DYNAL, Technical Handbook, "Biomagnetic Techniques in Molecular Biology" (DYNAL A.S., 1995).	
Examiner's Signature			Date Considered
		10/6/03	

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		Application Number	09/044,725 Unassigned		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Filing Date	August 29, 2000 Herewith		
		First Named Inventor	Paul M. Lizardi		
		Group Art Unit			
		Examiner Name			
Sheet	5	of	12	Attorney Docket Number	YU 115 CON (2) 2500-0001 US

OTHER ART -- NON PATENT LITERATURE DOCUMENTS			
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		ERNST, et al., "Cyanine dye labeling reagents for sulfhydryl groups" <i>Cytometry</i> 10:3-10 (1989).	
		FIRE & XU, "Rolling replication of short DNA circles", <i>Proc. Natl. Acad. Sci. USA</i> 92: 4641-4645 (1995).	
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		GERDES, et al., "Dynamic changes in the higher-level chromatin organization of specific sequences revealed by in situ hybridization in nuclear halos," <i>J. Cell Biol.</i> 126:289-304 (1994).	
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		GUO, et al., "Direct fluorescence analysis of genetic polymorphisms by hybridization with oligonucleotide arrays on glass supports", <i>Nucleic Acids Res.</i> 22(24): 5456-5465 (1994).	
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Examiner's Signature		Date Considered	6/6/03
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		First Named Inventor	Paul M. Lizardi
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Sheet	6	of	12
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H		HANVEY, et al., "Antisense and Antigene Properties of Peptide Nucleic Acids", <i>Science</i> 258: 1481-1485 (1992).	
		HATA, et al., "Structure of the Human Ornithine Transcarbamylase Gene", <i>J. Biochem.</i> 103: 302-308 (1988).	
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		HSUIH, et al., "Quantitative Detection of HCV RNA Using Novel Ligation-Dependent Polymerase Chain Reaction", <i>American Association for the Study of Liver Diseases</i> ; (Chicago, IL, November 3-7, 1995) [poster abstract].	
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Examiner's Signature		Date Considered	10/6/00
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Substitute for form 1449A/PTO		Complete If Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	69/044,723 Unassigned
		Filing Date	August 23, 2000 Herewith
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
		Examiner Name	
Sheet 7 of 12	Attorney Docket Number	WU 115 CON (2) 2500-000105	

OTHER ART — NON PATENT LITERATURE DOCUMENTS			
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[initials]		KABOORD & BENKOVIC, "Accessory proteins function as matchmakers in the assembly of the T4 DNA polymerase holoenzyme", <i>Current Biology</i> 5: 149-157 (1995).	
[initials]		KALIN, et al., "Evaluation of the ligase chain reaction (LCR) for the detection of point mutations", <i>Mutation Research</i> 283(2): 119-123 (1992).	
[initials]		KAPLAN, et al., "Rapid photolytic release of adenosine 5'-triphosphate from a protected analogue: utilization by the Na:K pump of human red blood cell ghosts" <i>Biochem.</i> 17:1929-1935 (1978).	
[initials]		KELLOGG, et al., "TaqStart Antibody™: "Hot Start" PCR Facilitated by a Neutralizing Monoclonal Antibody Directed Against Taq DNA Polymerase", <i>BioTechniques</i> 16(6): 1134-1137 (1994).	
[initials]		KERKHOF, "A Comparison of Substrates for Quantifying the Signal from a Nonradiolabeled DNA Probe", <i>Analytical Biochemistry</i> 205: 359-364 (1992).	
[initials]		KHRAPKO, et al., "Hybridization of DNA with Oligonucleotides Immobilized in Gel: A Convenient Method for Detecting Single Base Substitutions", <i>Molecular Biology (Mosk) (USSR)</i> 25: 718-730 (1991).	
[initials]		KING, et al., "Bridging the Gap", <i>Journal of Biological Chemistry</i> 269(18): 13061-13064 (1994).	
[initials]		KONG, et al., "Characterization of a DNA Polymerase from the Hyperthermophile Archaea <i>Thermococcus litoralis</i> ", <i>Journal of Biological Chemistry</i> 268: 1965-1975 (1993).	
[initials]		KOOL, "Circular Oligonucleotides: New Concepts in Oligonucleotide Design," <i>Annual Rev. Biomol. Struct.</i> 25:1-28 (1996).	
[initials]		KUNKEL, et al., "Rapid and Efficient Site-Specific Mutagenesis without Phenotypic Selection", <i>Methods in Enzymology</i> 154: 367-382 (1987).	
Examiner's Signature	[Signature]		Date Considered 10/6/03

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Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	00/644,733 Unassigned
		Filing Date	August 23, 2000 Newwith
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
		Examiner Name	
Sheet 8 of 12	Attorney Docket Number	YU 115 CON (2) 25006.0001 US	

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		LAMTURE, et al., "Direct detection of nucleic acid hybridization on the surface of a charge coupled device" <i>Nucleic Acids Research</i> 22(11): 2121-2125 (1994).	
		LANDEGREN, "Molecular mechanics of nucleic acid sequence amplification," <i>Trends Genetics</i> 9:199-202 (1993).	
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		LESNICK & FREIER, "Relative Thermodynamic Stability of DNA, RNA, and DNA:RNA Hybrid Duplexes: Relationship with Base Composition and Structure", <i>Biochemistry</i> 34: 10807-10815 (1995).	
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		LOCKHART, et al., "Expression monitoring by hybridization to high-density oligonucleotide arrays," <i>Nature Biotechnology</i> 14:1675-1680 (1996).	
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		Application Number	09/644,723 <i>Unassigned</i>		
		Filing Date	August 29, 2000 <i>Herewith</i>		
		First Named Inventor	Paul M. Lizardi		
		Group Art Unit			
		Examiner Name			
Sheet	9	of	12	Attorney Docket Number	YU 116 CON (2) 25006.000/145

OTHER ART -- NON PATENT LITERATURE DOCUMENTS			
Examiner's Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
		LUKYANOV, et al., "Molecule by molecule PCR amplification of complex DNA mixtures for direct sequencing: an approach to in vitro cloning," <i>Nucleic Acids Research</i> 20:1691-1696 (1996).	
		LUO, et al., "Improving the fidelity of <i>Thermus thermophilus</i> DNA ligase," <i>Nucl. Acids Res.</i> 24:3071-3078 (1996).	
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		MELTON, et al., "Efficient <i>in vitro</i> synthesis of biologically active RNA and RNA hybridization probes from plasmids containing a bacteriophage SP6 promoter", <i>Nucleic Acids Research</i> 12(18): 7035-7056 (1984).	
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Examiner's Signature	Date Considered <i>12/6/82</i>
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		Application Number	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		09/644,723	
		Unassigned	
		Filing Date	
		August 23, 2000	
		First Named Inventor	
		Paul M. Lizardi	
		Group Art Unit	
		Examiner Name	
		Attorney Docket Number	
		YU 445-00N (2) 2500-0001 US	
Sheet	10	of	12

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		NARANG, et al., "Chemical Synthesis of Deoxypolynucleotides by the Modified Triester Method", <i>Methods Enzymology</i> 65: 610-620 (1980).	
		NEWTON, et al., "Analysis of any point mutation in DNA. The amplification refractory mutation refractory mutation system (ARMS)", <i>Nucl. Acids Res.</i> 17:2503-2516 (1989).	
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		NILSSON, et al., "Padlock Probes: Circularizing Oligonucleotides for Localized DNA Detection", <i>Science</i> 265: 2085-2088 (1994).	
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		PANASNKO, et al., "A Simple, Three-Step Procedure for the Large Scale Purification of DNA Ligase from a Hybrid λ Lysogen Construction <i>in Vitro</i> , <i>Journal Biological Chemistry</i> 253: 4590-4592 (1978).	

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Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)		Application Number	00/644,723 Unassigned
		Filing Date	August 23, 2000 Herewith
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
		Examiner Name	
Sheet 11 of 12	Attorney Docket Number	YU 115 CON(2) 25006.000465	

OTHER ART -- NON PATENT LITERATURE DOCUMENTS			
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		PEASE, et al., "Light-generated oligonucleotide arrays for rapid DNA sequence analysis", <i>Proc. Natl. Acad. Sci. USA</i> 91(11): 5022-5026 (1994).	
		PIATAK, et al., "High Levels of HIV-1 in Plasma During All Stages of Infection Determined by Competitive PCR", <i>Science</i> 259(5102): 1749-1754 (1993).	
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Examiner's Signature		Date Considered	10/6/07
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<p>Substitute for form 1449A/PTO</p> <p>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</p> <p>(use as many sheets as necessary)</p>		Complete if Known	
		Application Number	09/644,729 unassigned
		Filing Date	August 29, 2000 - Kuroishi
		First Named Inventor	Paul M. Lizardi
		Group Art Unit	
		Examiner Name	
Sheet 12 of 12	Attorney Docket Number	YU 115 CON (2) 2,5006,000145	

OTHER ART -- NON PATENT LITERATURE DOCUMENTS			
Examiner's Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published	T ²
Kuroishi		SAKSELA, et al., "Human immunodeficiency virus type 1 mRNA expression in peripheral blood cells predicts disease progression independently of the numbers of CD4 ⁺ lymphocytes", <i>Proc. Natl. Acad. Sci. USA</i> 91(3): 1104-1108 (1994).	
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		SKALITER & LEHMAN, "Rolling circle DNA replication <i>in vitro</i> by a complex of herpes simplex virus type 1-encoded enzymes", <i>Proc. Natl. Acad. Sci. USA</i> 91(22): 10665-10669 (1994).	

Examiner's Signature	<i>Kuroishi</i>	Date Considered	10/6/03
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